

09/601,029 to Himmelsbach et al,
Response filed 7 Feb 2004

Beiersdorf-631

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-34 were pending in the application. The claims stand objected/rejected under various statutory provisions. Each objection/rejection is addressed in sequence below.

Claims 1, 12 and 16 have been amended; claims 3 and 9 have been canceled.

New claims 35 and 36 are dependent claims reciting the subject matter deleted from claims 12 and 16, respectively.

No amendment introduces new matter.

Claim Objections

Claim 9 has been canceled, thus, this objection is now moot and can be withdrawn.

Claim Rejections Under § 112

Claims 12 and 16 have been amended by deleting the offending terminology.

Withdrawal of the rejection is requested.

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Double Patenting

Applicants respectfully request withdrawal of the double patenting rejection over claims 1-27 of US '730 to Albrod, in view of the subject matter claimed therein.

Specifically, Albrod's backing material as claimed, does not comprise any pharmacologically active agents, and thus, cannot reasonably be viewed as a predicate for a double patenting rejection.

Withdrawal of the double patenting rejection is requested.

Anticipation and/or Obviousness by Lucast

Claims 1, 7-9, 11-14, 16-18, 20, 24, 29, 30 and 33 are alleged to be anticipated by Lucast.

Claims 4, 10, 25 and 26 are alleged to be either anticipated or obvious in view of Lucast.

As a first response, it is noted that claim 3 was canceled, and the subject matter incorporated into amended claim 1. It is believed that this amendment overcomes Lucast.

Further, Lucast did not anticipate or render obvious, the unamended claim1, because Examiner's reference to benzoyl peroxide as a pharmacologically active agent is completely incorrect.

Benzoyl peroxide is added because it is one of the most commonly used initiators of polymerization. This is why it is added to the *monomer* solution, not the completely polymerized adhesive composition. During initiation the benzoyl peroxide forms highly reactive free radicals that actually add to the polymer, and thus, renders them unavailable for any other function, including as a pharmacological agents.

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Lucast also polymerizes the mixtures at 65 °C for 8 hours, conditions which would consume all of this thermally unstable peroxide in the polymerization and/or various side reactions including degrading into phenyl groups.

In sum, the completed article disclosed by Lucast would not have a pharmacologically active agent because the benzoyl peroxide is used up in the polymerization reaction.

Number of Stitches/cm

Amended claim 1, requires that the backing be at least 3 stitches/cm and up to 30/cm. Examiner acknowledges that this parameter constitutes a result effective variable. However, inexplicably, Examiner then apparently disregards this fact.

It is noted that MPEP 2144.05 section II (Optimization of Ranges) states "*A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).*"

However, this recognition must be supplied by the prior art, and not Examiner's speculation. It is not sufficient that Examiner intuits that the nature of stitching may affect a fabric's properties. See MPEP § 2144.05, citing "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)."

In addition, it appears that the Examiner is using hindsight to reject claims expressing this limitation. How does Examiner know that it would be obvious to use at least 5-50 stitches/cm? Why wouldn't persons in the art conclude that routine optimization of this variable would be at 1-10, or 25-100 or 125-200 stitches/cm? The clear answer is that we cannot make this determination based on the prior art, and therefore, the rejection is not proper.

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Examiner is simply using the claimed value as a road map to reconstruct with hindsight, his own purposeful but unsubstantiated view of what is obvious and routine in the art.

This mode of analysis violates PTO guidelines cautioning against improper hindsight in obviousness determinations. Further, as stated above, the instant rejection misapplies the guidelines of MPEP § 2144.05.

Thus, all rejections over Lucast should be withdrawn because Lucast does not teach or suggest, [a] an adhesive composition having a pharmacologically active agent; or [b] the frequency of longitudinal stitching of the backing material., and [c] does not teach or suggests that stitch frequency is a result effective variable.

Obviousness over Merkle in view of Ganschow.

It is noted that claim 3, was not among the claims rejected by the combination of Merkle/Ganschow.

Accordingly, newly amended claim 1 overcomes these rejections.

CONCLUSION

It is believed that the foregoing amendments and comments are sufficient to address Examiner's objection and rejections. Accordingly, allowance of the claims is respectfully requested.

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